Reply Dated December 18, 2003
Serial No. 09/740,052

REMARKS

Reconsideration of the rejections set forth in the office action is respectfully requested in view of the following remarks. Currently, claims 1, 3-10, and 12-18 are pending in this application.

Rejection of claims 1, 3-10, and 12-18 over Ma in view of Arrow.

This invention relates to a method for a server to manage bandwidth of a link. (p. 2, lines 6-7). In claim 1, applicants recite a method comprising the steps of: assigning by a VPN server a portion of bandwidth on a remote link to at least one application group; and metering by the VPN server packets belonging to the application group. Also, claim 1 recites that the VPN server is configured to at least one of authenticate, encapsulate, and de-encapsulate at least a portion of the packets.

The Examiner has contended that Ma teaches the steps of assigning bandwidth and metering packets, but concedes that Ma does not teach that its network element should authenticate, encapsulate, or de-encapsulate the packets that it is metering.

The Examiner then contends that Arrow discloses a data communication system comprising a VPN management station 160 configured for authentication, encryption, and compression of packets.

Applicants respectfully submit that the server 160 and the centralized call admission control usage monitor 145 of Ma would not be able to perform authentication, encryption, and compression of the packets on the tunnels that it is monitoring, even if Arrow and Ma were combined. Specifically, Claim 1 states that the same VPN server must perform three things: (1) assign a portion of the bandwidth of a remote link to at least one application group, (2) meter

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packets belonging to the application group; and (3) at least one of authenticate, encapsulate, and de-encapsulate at least a portion of the packets. The server 160 in Ma may allocate bandwidth on links, but it doesn't actually handle the packets on the link. Thus, it cannot possibly be configured to "at least one of authenticate, encapsulate, and de-encapsulate at least a portion of the packets."

Arrow teaches a "system manager" that is configured to define VPN parameters for authentication, encryption, and compression functions to be associated with newly created VPNs. Col. 15, lines 52-55. A person of ordinary skill in the art would not be motivated by this teaching to modify the server 160 in Ma to perform the method claimed in claim 1. Specifically, simply defining authentication, encryption, and compression functions to be used on a VPN tunnels does not teach or suggest that a centralized server (such as the server 160 in Ma) should be modified to enable that server to also perform functions on the packets on the various VPN tunnels. Applicants note that encryption and de-encryption operations are very computationally intensive. See MPEP 2145 (a combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose.) Accordingly, applicants respectfully request that the rejection be withdrawn.

The Examiner included a section in the Office Action entitled "Response to Arguments" in which the Examiner has asserted that "the features upon which applicant relies... are not recited in the rejected claim(s)." page 6-7. Applicants respectfully disagree.

Applicants have been trying to explain that the VPN server must do several things, one of which is perform authentication, encapsulation, and de-encapsulation of at least a portion of the packets belonging to the application group. The centralized controllers discussed in the two cited references, Ma and Arrow, are not capable of doing this because they don't actually handle

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traffic on the tunnel. When applicant discussed the fact that the device sits on the end of a VPN tunnel and is configured to manage bandwidth on the tunnel, applicant was referring to the fact that the claims require the VPN server to actually handle tunnel traffic and perform specific operations on the packets. Thus, the claims do recite limitations that distinguish the applied combination of references.

The Examiner has further taken the position that "there is no requirement that a motivation to make the modification be expressly articulated." This is legally incorrect. The Examiner has an obligation in the first instance to articulate the motivation for combining the references. Also, as set forth in the first sentence of MPEP 2143.01, "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." MPEP 2143.01, 8th ed. p. 2100-123. In making this determination, "it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification. Accordingly, applicants respectfully submit that there is an obligation on the part of the Examiner to state where the references suggest the desirability of the combination or how the knowledge in the art would propose the combination. Absent this, there is no prima facie case that the claims in the application are obvious.

Request to withdraw decision to make Office Action Final

On page 7 of the Office Action, the Examiner stated that "The argument made by the applicant about the VPN management station 160 is not defining these parameters for it self is not considered in that the feature was not recited in the rejected claims." The assertion that the

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claims do not recite this feature is incorrect. Claim 1 recites that the VPN server is configured to perform assigning, metering, and at least one of authentication, encapsulation, and de-encapsulation on the packets that are metered. In light of the fact that these arguments were not considered by the Examiner, it is clear that applicant's amendments could not have necessitated the new grounds of rejection presented in the Office Action. Specifically, the claims and the arguments have, as stated by the Examiner, not been considered in the first instance. Accordingly, applicant respectfully requests the Examiner to consider these grounds at this point and withdraw the finality of the previous Office Action.

Conclusion

Because the combination of Arrow and Ma fail to teach or suggest the limitations of claim 1, applicants respectfully request that the rejection of claim 1 under 35 U.S.C. 103 be withdrawn. Independent claims 3, 5, 8, 9, 10, 12, 14, 17, and 18, contain similar limitations and are therefore patentable for at least the same reasons.

In view of foregoing claim amendments and remarks, it is respectfully submitted that the application is now in condition for allowance and an action to this effect is respectfully requested. If there are any questions or concerns regarding the amendments or these remarks, the Examiner is requested to telephone the undersigned at the telephone number listed below.

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If any fees are due in connection with this filing, the Commissioner is hereby authorized to charge payment of the fees associated with this communication or credit any overpayment to Deposit Account No. 502246 (Ref: NN-13361).

Respectfully Submitted

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